REMARKS

Claim 1 has been amended. Claims 10-25 and 33-39 have been canceled without prejudice, and Applicants reserve the right to re-present the canceled claims and similar claims in a divisional application. The Examiner has withdrawn from consideration Claims 17-25, 33-35 and 38-40. As discussed below, Applicants traverse the restriction requirement with respect to Claim 40, and, thus, Claims 1-9, 26-32 and 40 are currently pending in the application.

Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 1-9 and 26-32 stand rejected under the cited prior art. Specifically, the Examiner rejected Claims 1-9 and 26-32 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,088,686 ("Walker"). Reconsideration of the rejections is respectfully requested.

Restriction Requirement

In the previous Amendment, Applicants submitted new independent Claim 39 and new dependent Claim 40, which depends from Claim 1. In the present Office action, the Examiner has indicated that the elected Claims 1-9 and 26-32 are independent and distinct from new Claims 39 and 40. It appears that the Examiner believes that new Claim 40 depends from new Claim 39; however, new Claim 40 depends from Claim 1, which has been elected for prosecution.

Applicants have canceled new Claim 39. Applicants traverse the Examiner's restriction requirement of new Claim 40. Accordingly, Claim 40 remains pending in the application.

Examiner's Response to Arguments

In the previous Office action, the Examiner acknowledged that Walker does not explicitly teach the step of electronically generating a score for the applicant based on the credit bureau data and the account information. See Office action, mailed October 21, 2003, paragraph 7. However, the Examiner took Official Notice that the step of generating a score for the applicant based on credit bureau data and account information is old and well known in the art. Id. The Examiner contended that this step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. Id. Further, the Examiner contended that this step also helps them [the financial institution] offer products to their customer based on their credit score. Id.

In the previous Amendment, dated January 21, 2004, Applicants respectfully traversed the Examiner's reasons for taking Official Notice. Applicants stated in the previous Amendment:

> In general, financial institutions can obtain, access, and use different data for different purposes. A score may be generated or calculated in a numerous different ways, and each score may have a different meaning for each financial institution. In the present application, the score that is generated is not a credit score, as that term is used in the art. In the art, a credit score is generally pre-calculated by a credit bureau, and that score can differ depending on the credit bureau accessed. Applicants respectfully request that the Examiner present a reference that discloses generating a score based on credit bureau data and account information data. Absent such a reference, Applicants respectfully submit that the act of generating a score for the applicant based on the credit bureau data and the account information is not old and well known in the art.

In the present Office action, the Examiner maintains the Official Notice and presented U.S. Patent No. 6,119,103 ("Basch") in support of the Official Notice that the step of generating a score for the applicant based on credit bureau data and account information is old and well known in the art. The Examiner contends that "inputs to the FRPS module in Basch include both credit bureau data as well as account information and the output includes a financial risk score" is disclosed at col. 7, line 30-col. 8, line 2 and col. 9, lines 22-33 of Basch. See Office action mailed March 11, 2004, page 5.

Applicants respectfully disagree that Basch discloses generating a score for the applicant based on credit bureau data and account information. Basch discloses a financial risk prediction system ("FRPS") 100 for assessing the level of financial risk pertaining to an account and/or account holder based on scoreable transactions. Col. 6, lines 54-58. Scoreable transactions represent events pertaining to an account and/or an account holder that impact the financial risk level of that account and/or account holder. Col. 5, lines 8-11. Examples of scoreable transactions include authorization requests for purchases of goods or services made on credit, clearing and settlement transactions between merchants and account issuers pertaining to one or more accounts, account issuer-supplied account records, public records, and the like. Col. 5, lines 11-16. Credit bureau data is not included in this list.

Furthermore, Basch teaches away from using credit bureau data to generate a financial risk score. As stated in Basch, "credit bureau data typically pertains only to account data, e.g., account types, account limits, and historical payment information." Col. 2, lines 18-20. In

addition, "the data kept by credit bureaus is significantly dated since data from the various account issuers is typically not updated with the credit bureaus until after the end of each billing cycle." Basch, col. 2, lines 20-24. Continuing, "the credit bureaus typically do not have accurate or adequate data pertaining to the credit performance of a particular account holder in between reporting periods. Since credit bureau scores are not based on financial transaction data, a credit bureau would not be able to ... warn account issuers that certain accounts and/or account holders are at risk based on the recent transactions." Basch, col. 2, lines 25-31.

Again, Applicants respectfully traverse the Examiner's reasons for taking Official Notice. In general, financial institutions can obtain, access, and use different data for different purposes. A score may be generated or calculated in a numerous different ways, and each score may have a different meaning for each financial institution. In the present application, the score that is generated is not a credit score, as that term is used in the art. In the art, a credit score is generally pre-calculated by a credit bureau, and that score can differ depending on the credit bureau accessed. Applicants respectfully request that the Examiner present a reference that discloses generating a score based on credit bureau data and account information data. Absent such a reference, Applicants respectfully submit that the act of electronically generating a score for the applicant based on the credit bureau data and the account information is not old and well known in the art.

Claim Rejections – 35 U.S.C. § 101

The Examiner indicates that Claim 1 of the invention is directed to non-statutory subject matter. The Examiner contends that Claim 1 is drawn to a method of automatically evaluating a financial account applicant for a financial institution that is not tied to any technological art. The Examiner also that Claim 1 of the invention is directed merely to a human making mental computations and manually plotting results on paper, and thus are nothing more than an abstract idea, which is not tied to any technological art, and is not a useful art as contemplated by the Constitution. See Office action, mailed March 11, 2004, page 4.

Applicants respectfully disagree but, to further prosecution, have amended Claim 1 to address this rejection. Accordingly, Applicants respectfully request reconsideration of the rejection of Claim 1 under 35 U.S.C. § 101.

Claim Rejections – 35 U.S.C. § 103

      The Examiner rejected Claims 1-9 and 26-32 under 35 U.S.C. §103 as being unpatentable over Walker. Reconsideration of the rejections is respectfully requested.

      To establish a *prima facie* case of obviousness under Section 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. Moreover, it is improper to combine references where the references teach away from their combination. Applicants respectfully submit that the proposed combination of references does not meet the above criteria with respect to the subject matter of the claims.

      Independent Claim 1 defines a computer-implemented method of automatically evaluating a financial account applicant for a financial institution. The method is defined as comprising the acts of electronically accessing credit bureau data for the applicant, electronically accessing account information for the applicant, electronically generating a score for the applicant based on the credit bureau data and the account information, and determining whether to open the financial account based on the score.

      Walker discloses a system and method for on-line processing of credit applications. The system includes a financial network terminal 14, a front-end processing and communications system 16, and an ACAPS processing system 26, which accesses various databases. Col. 12, lines 36-48; FIGS. 1A-1B. A local branch representative ("LBR") 12 enters applicant data and the requested credit product. Col. 13, lines 5-12. The entered data is transferred to the ACAPS system 26 for on-line review and approval decision processing. Col. 13, lines 13-18.

      The ACAPS system 26 accesses existing customer information stored in databases 18, 20, and 22 to determine a relationship code, which is used to identify price offers for the credit products. Col. 13, lines 19-47. The ACAPS system 26 proceeds to perform a front-end pre-screening process to identify any credit-qualified offers that the LBR 12 can present to the customer 10. Col. 13, lines 48-67. If the customer 10 accepts any of the offers, the credit qualified offer is converted to a request for credit, which requires on-line credit processing for

final decision. Col. 14, lines 1-4. The ACAPS system 26 performs a fraud verification, and, if the applicant data passes, the ACAPS system 26 gathers credit bureau reports. Col. 14, lines 17-27. The ACAPS system 26 performs a disaster/policy screening, and, if the applicant data passes, a disaster response code (e.g., A, B, C, or D) is assigned to the application. Col. 14, lines 28-36; col. 7, lines 30-50; FIG. 41.

The ACAPS system 26 continues to process the application by performing a debt burden verification, and, if the applicant data passes, a debt burden response code is assigned to the application. Col. 14, lines 37-46; col. 7, lines 30-50; FIG. 41. The ACAPS system 26 selects the worst response code between the disaster response code and the debt burden response code, which becomes the credit decision subcode. Col. 14, lines 47-49; col. 7, lines 30-50. The credit decision subcode or scoring response code is used to determine where the scoring response code falls within certain predetermined turndown cutoff ranges (e.g., Hard Approval, Investigate Reject-1, Investigate Reject-2, or Hard Reject-3) in order to assign a status code (e.g., RA-recommend approval, CA-conditional approval, CO-counter-offer approval, or RT-recommend turndown) to the application. Col. 14, lines 47-col. 15, lines 21; FIG. 9. The status code determines whether to accept or reject the application or whether to provide a conditional approval of the application. Id.

If the applicant requests a bankcard, the ACAPS system 26 performs additional processing. Col. 15, lines 22-25. The applicant data and requested product information is transferred to the bankcard account fulfillment system ("AFS") 40. If the applicant data passes the AFS 40 requirements, the requested product is assigned a credit limit based on either the application credit score and applicant income or the applicant's bank relationship amount and income. Col. 15, lines 39-43. The AFS 40 performs a maximum debt burden offer if the assigned credit limit is within a certain range to calculate a credit limit. Col. 15, lines 45-60; col. 7, lines 58-66; col. 8, lines 5-10. If the applicant 10 is not a student, a non-resident alien or self-employed, the AFS 40 assigns a bank liability balance response code (e.g., A, B, C, or D) to the application. Col. 15, line 61-col. 16, line 15; col. 7, lines 30-50).

The ACAPS 26 selects the better of the liability balance response code and the credit response code as the final response code. Col. 16, lines 15-18; col. 7 lines 30-50. Based on the final response code, the automated review of the applicant data, and the scoring response code, the ACAPS 26 presents an automated credit offer decision. Col. 16, lines 19-21.

Walker does not teach or suggest, among other things, a computer-implemented method of automatically evaluating a financial account applicant for a financial institution including the act of generating a score for the applicant based on the credit bureau data and the account information. Rather, Walker discloses a system that assigns a first alpha response code to disaster screening data and a second response code to debt burden data. The system of Walker selects the worst response code to be the credit decision subcode. The system of Walker assigns a third alpha response code to bank liability data, and the system selects the better of the credit decision subcode and the bank liability response code as the final alpha response code. The system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code (as in the credit decision subcode and the final response code). In other words, in the system of Walker, the specific data is considered independently of other data when assigning the response codes – the data is not combined prior to assigning a response code. Walker does not teach or suggest generating a score for credit bureau data and applicant account information. Again, the system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code.

The Examiner acknowledges that Walker does not explicitly teach the step of electronically generating a score for the applicant based on the credit bureau data and the account information. See Office action, mailed October 21, 2003, paragraph 7. However, the Examiner takes Official Notice that the step of generating a score for the applicant based on credit bureau data and account information is old and well known in the art. Id. The Examiner contends that this step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. Id. Further, the Examiner contends that this step also helps them [the financial institution] offer products to their customer based on their credit score. Id.

Applicants respectfully traverse the Examiner's use of Basch to support the Official Notice. As discussed above, Applicants respectfully disagree that Basch discloses generating a score for the applicant based on credit bureau data and account information. Specifically, Basch discloses using data other than credit bureau data to generate a financial risk score. More specifically, Basch teaches away from using credit bureau data to generate a financial risk score as discussed above. Therefore, Applicants respectfully request that the Examiner present a

reference that discloses generating a score based on credit bureau data and account information data. Absent such a reference, Applicants respectfully submit that the act of electronically generating a score for the applicant based on the credit bureau data and the account information is not old and well known in the art.

For these and other reasons, Walker does not teach or suggest the subject matter defined by independent Claim 1. Accordingly, independent Claim 1 is allowable. Dependent Claims 2-8 and new dependent Claim 40 depend from independent Claim 1 and are allowable for the same and other reasons. In addition, the additional subject matter defined by the dependent claims, such as, for example, Claim 40, provides separate bases for allowance.

New dependent Claim 40 further specifies that the score is a numerical score. Walker discloses a system that assigns alpha response codes to certain data. The system of Walker does not teach or suggest generating a numerical score. For these and other reasons, Walker does not teach or suggest the additional subject matter defined by Claim 40.

Independent Claim 9 defines a computer-readable medium storing computer-readable instructions for evaluating a financial account applicant, the instructions directing the computer to perform the acts of accessing credit bureau data for the applicant, accessing account information for the applicant, generating a score for the applicant based on the credit bureau data and the account information, and determining whether to open the financial account based on the score.

Walker does not teach or suggest, among other things, a computer-readable medium that stores computer-readable instructions that performs the act of generating a score for the applicant based on the credit bureau data and the account information. Rather, Walker discloses a system that assigns a first alpha response code to disaster screening data and a second response code to debt burden data. The system of Walker selects the worst response code to be the credit decision subcode. The system of Walker assigns a third alpha response code to bank liability data, and the system selects the better of the credit decision subcode and the bank liability response code as the final alpha response code. The system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code (as in the credit decision subcode and the final response code). In other words, in the system of Walker, the specific data is considered independently of other data when assigning the response codes – the data is not combined prior to assigning a response code. Walker does not

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teach or suggest generating a score for credit bureau data and applicant account information. Again, the system of Walker merely assigns independent response codes to specific data and selects the best or worst response code to be the combined response code.

The Examiner acknowledges that Walker does not explicitly teach the step of generating a score for the applicant based on the credit bureau data and the account information. See Office action, mailed October 21, 2003, paragraph 7. However, the Examiner takes Official Notice that the step of generating a score for the applicant based on credit bureau data is old and well known in the art. Id. The Examiner contends that this step enables each financial institution to develop their own scoring model based on weighting of factors they deem important. Id. Further, the Examiner contends that this step also helps them [the financial institution] offer products to their customer based on their credit score. Id.

Applicants respectfully traverse the Examiner's use of Basch to support the Official Notice. As discussed above, Applicants respectfully disagree that Basch discloses generating a score for the applicant based on credit bureau data and account information. Specifically, Basch discloses using data other than credit bureau data to generate a financial risk score. More specifically, Basch teaches away from using credit bureau data to generate a financial risk score as discussed above. Therefore, Applicants respectfully request that the Examiner present a reference that discloses generating a score based on credit bureau data and account information data. Absent such a reference, Applicants respectfully submit that the act of electronically generating a score for the applicant based on the credit bureau data and the account information is not old and well known in the art.

For these and other reasons, Walker does not teach or suggest the subject matter defined by independent Claim 9. Accordingly, independent Claim 9 is allowable. Dependent Claims 26-32 depend from independent Claim 9 and are allowable for the same and other reasons.
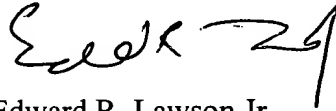
CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 1-9, 26-32 and 40 are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

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